

IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

APPEAL UNDER SECTION 109 No 23 of 1993

For Approval and Signature:

Hon'ble MR.JUSTICE R.BALIA.

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1. Whether Reporters of Local Papers may be allowed to see the judgements?
2. To be referred to the Reporter or not?
3. Whether Their Lordships wish to see the fair copy of the judgement?
4. Whether this case involves a substantial question of law as to the interpretation of the Constitution of India, 1950 of any Order made thereunder?
5. Whether it is to be circulated to the Civil Judge?

CADILA ANTI BIOTICS PVT. LTD.

Versus

HANSA HARSHAD SHROFF C/O.CHARAK PHARMACEUTICALS

Appearance:

MR RR SHAH for Petitioner
MR MV CHOKSHY for Respondent No. 4
Respondent No. 5 is served
Respondent No. 6 is served

CORAM : MR.JUSTICE R.BALIA.

Date of decision: 25/06/98

ORAL JUDGEMENT

1. Heard learned counsel for the appellant. None appears of other parties.

2. The appellant is non-successful applicant before the Assistant Registrar of Trade Marks, Ahmedabad, for registering 'DEPIN' - trade mark in class 5 for

pharmaceutical and medicinal preparations.

3. The appellant has moved an application on 7th December, 1984 which was registered as Application No. 430779 for registering as trade mark word 'DEPIN,, in respect of pharmaceutical and medicinal preparations. The mark was adopted by the applicants for the first time in the year 1984 itself for the purpose of registration under the Act. It was not being used by the appellant prior to that date. On 16.7.1989 the application was advertised. The respondents lodged their opposition on 11th September, 1989 alleging that they are registered proprietors of trade mark 'DEEPAN, in respect of pharmaceutical preparation for the treatment of dysentery and bacillary diarrhoea. Trade mark is registered under No. 287293. The registration is valid and subsisting. It was also urged by the opponents that the said registered trade mark DEEPAN is in use since 1st August, 1961 on a large and extensive scale throughout the length and breadth of India. In support of this claim, the price list of 1963, 1970 and 1979 along with sale figures from the year 1979 to 1988-89 showing the gradual increase in the figure of sale had been produced before the authority. The Assistant Registrar found that the trade mark which is the property of the opponents, and the trade mark sought to be registered are phonetically so similar that they are likely to cause deception and/or confusion in the minds of the purchaser of the commodity as the commodities in respect of which the impugned trade mark is sought to be used, and the opponent's trade mark operates are in the same field, to be used for treating similar ailments. The Asst. Registrar referred to the test stated by Justice Parker in Pionotist Co. Ltd's case, that 'you must take the two words, you must judge of them both by their look and by their sound and you must consider the goods to which they are to be applied. You must consider the nature and the kind of customer who would likely to buy those goods. You must consider all the surrounding circumstances and you must further consider what is likely to happen if each of those trade marks is used in normal way as a trade mark for the goods by the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but there will be a confusion in the mind of the public which will lead to confusion in the goods then you may refuse the registration or rather you must refuse registration in that case'. This principle since then well settled and has been approved by the Apex Court. Applying the aforesaid principle, the Assistant

Registrar was of the view that visually and phonetically, two marks are almost identical. In view of the deceptive similarity of the two marks visually and phonetically, the applicant is not entitled to registration of impugned word 'DEPIN' as trade mark in view of Section 12(1) of the Act which provide save as provided in sub-section (3) no trade mark in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods. Like wise he also held that the use of mark by applicant is likely to cause confusion and deception amongst substantial number of persons. The customer will be put in a state of wonder that either it is another product from the opponents or that the applicants are in some way connected with the opponents. He also found that the mark sought to be registered by appellants falls under Sec.11(a), which states that a mark the use of which would be likely to deceive or cause confusion shall not be registered. Last contention by the applicant that in spite of the fact that the impugned mark may be considered as identical with the trade mark which is already registered in the name of different proprietor in respect of same goods, his case for registration be considered under sub-section (3) of Sec.12 on the basis of honest concurrent use of the trade mark and the special circumstances that so far no case of infringement or opposing the goods has been filed against the applicant was also not accepted by the Registrar by holding that there are no other special circumstances which require for registering the trade mark in favour of the appellant.

4. This order dated 27th December, 1990 is under challenge in this appeal. The appellant has filed a Misc. Petition on 2nd April, 1991 which was later allowed to be converted in Appeal under Sec. 109 of the Act of 1958.

5. Learned counsel for the appellant Mr. Shah urged that firstly appellant is seeking registration of a mark in Schedule 'H' of pharmaceutical and medicinal preparations which can be sold on the prescription of a doctor. Therefore, it cannot be said to be a registration of the mark in respect of similar or identical commodity of which the opponent is a registered proprietor. Secondly, it was urged that the applicant intended to get registration under Sec. 12(3) as honest concurrent use or of other special circumstances stated above, Registrar ought to have exercised his discretion in appellant's favour.

6. Having carefully considered the contention of the learned counsel for the appellant, I am of the opinion that there is no substance in either of contention. Firstly, commodity marketed by both the rival claimants is in the field of medicines meant for treatment of human diseases. Both the medicines can be considered to the goods of the same description sofar as consumers are concerned. May be for different diseases, different medicines are prescribed. Moreover, it is to be noticed that the prohibition under Section 11 (a) which prohibits the use of which is likely to deceive or cause confusion is much wider and stricter than sub-section(1) of Sec. 12 which states where the registration of a mark as sought in respect of any goods which is identical with or deceptively similar to a trade mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods, namely, the identity of goods in relation to which the existing trade mark and one under the application is to be compared is a pre-condition. If the contention of the learned counsel for the appellant is to be accepted that its application was liable to be considered subject to sub-section(3) of Section 12, then his contention that the goods are not similar because of the appellant's trade mark is in relation to a schedule drug must fail. It must be noticed that while sub-sec. (1) of Sec. 12 states the prohibition is subject to the provision of sub-sec. (3) of Section 12, there is no such saving where prohibition directly emerges under Section 11. Thus, where a mark the use of which is likely to deceive or cause confusion, it cannot be registered even under sub-section (3) of Section 12 unless it is further shown that the already registered mark and the mark required to be registered is in relation to the same goods or the same description of goods, which contention also do not exist.

7. Even otherwise, if the provision of sub-section (1) of Section 12 is fulfilled, grant of registration under sub-section (3) is not a matter of course but is in the discretion of the Registrar. If the Registrar keeping in view the facts and circumstances of the case and keeping in view the damage which is likely to be caused because of existence of likelihood of deception or causing of confusion with the user of two trade marks in relation of same goods or goods of similar description on the one hand and the loss which is likely to be caused on account of honest concurrent user of the mark by denying him the registration, the discretion exercised by the Registrar is on sound principle. It is apparent from the

facts that while opponents has proved user of mark by him since 1961 the appellant has for the first time applied for registration of mark in 1984 and it did not claim any prior use of the mark. The application was for 'proposed use'. Thus as on date of application there was no question of honest and concurrent user. Discretion under sub Sec.(3) of Sec. 12 cannot be exercised for permitting further use of mark, where it is hit by Sec. 12(1) read with Sec. 11(a). One cannot say that there may be an honest concurrent future use of a mark, which is identical or deceptively similarly to existing mark already in use. For invoking discretion under Sec. 12(3) the mark must already be in use bona fide along with other mark. The word 'concurrent' clearly indicates that sub sec. (3) can only operate when both marks are simultaneously in use and such concurrent use already in existence can be permitted to continue only if the simultaneous use by the applicant has been bona fide. From the evidence produced before it, the learned Assistant Registrar has come to the conclusion on the basis of sale figures of 1979 to 1988-89 that opponent,s sale figures since 1979 are impressive and there is nothing on the record to suggest what prompted the appellants to adopt a mark similar to it for proposed use in respect of commodity in the same field for the first time in 1984.

8. Ordinarily, court in appeal does not interfere in exercise of discretion unless the same has been exercised capriciously or arbitrarily and injudiciously. I am of the opinion that the Assistant Registrar has not exercised his discretion in the manner which is liable to be interfered with in Appeal. Appeal, therefore, fails and is dismissed. There shall be no order as to costs.

p.n.nair